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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/814,174	03/21/2001	Agustin Alberto deROJAS	39015-002	2803

7590 10/31/2003  
Proskauer Rose LLP  
Patent Department  
1585 Broadway  
New York, NY 10036

EXAMINER

HASAN, MOHAMMED A

ART UNIT PAPER NUMBER

2873

DATE MAILED: 10/31/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/814,174

Applicant(s)

DEROJAS ET AL.

Examiner

Mohammed Hasan

Art Unit

2873

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) 1-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 17, 20, 21, 24, and 26-28 is/are rejected.
- 7) ☒ Claim(s) 18, 19, 22, 23, 25 and 29 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2 and 3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Oath/Declaration***

1. Oath and declaration filed on 3/21/2001 is accepted.

### ***Information Disclosure Statement***

2. The prior art documents submitted by applicant in the Information Disclosure Statement filed on February 10, 2003 and July 30, 2001 have all been considered and made of record (note the attached copy of form PTO – 1449).

### ***Election/Restrictions***

3. Applicant's election without traverse of claims 17 – 29 are drawn to a photochromic lens in Paper No. 3 is acknowledged.

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 24, and 26 – 28 are under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and / or use the invention.

In claim 24, applicant does not disclose elastomeric material selected from the group consisting of: polydimethylsiloxanes, ethyl vinyl acetates, polysulfates and mixture thereof.

In claim 26, applicant does not disclose photochromic dye is selected from the group of reversible photochromic compound consisting of: Spiroindolinonaphthoxazine and mixture thereof.

In claim 27, applicant does not disclose the composition of the lens is selected from the group consisting of optical quality resin materials consisting of diethylene glycol diallyl carbonate, allyl diglycol carbonates, allylic esters, acrylic esters, acrylates, methyl, allyl and butyl methacrylates, styrenics, polyesters, triallyl cyanurate, triallyl phosphate, triallyl citrate, diallyl phenyl phosphonate, urethanes, epoxies and silicon.

### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the

applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 17, 20, 21, 24, and 26 – 28 are rejected under 35 U.S.C. 102(e) as being anticipated by Krishnan et al (6,065,836).

Regarding claim 17, Krishnan et al discloses (column 14, lines 46) a photochromic lens comprises a lens coated with an elastomeric film in which a photochromatic dye is dispersed (column 14, lines 46, column 2, lines 58 - 66).

Regarding claim 20, Krishnan et al discloses, wherein the lens has an activation time of less than 30 seconds (as shown in tables 3 and 4).

Regarding claim 21, Krishnan et al discloses, wherein the lens has a deactivation time of less than 30 seconds (as shown in tables 3 and 4).

Regarding claim 24, Krishnan et al discloses elastomeric film is made from an elastomeric material selected from the group consisting of: silicones, polyurethanes, thermoplastic, elastomers, fluorelastomers, copolyester elastomers, chlorosulfonated polyethylenes, neoprenes (column 2, lines 59 – 60).

Regarding claim 26, Krishnan et al discloses photochromic dye is selected from the group of reversible photochromic compounds consisting of: spirooxazine, naphthopyran, chromene (column 6, lines 7 – 12).

Regarding claim 27, Krishnan et al discloses the composition of the lens is selected from the group consisting of optical quality resin materials consisting of: polycarbonates (column 2, lines 64 – 66).

Regarding claim 28, Krishnan et al discloses, an optical quality resin is a polycarbonate resin (column 2, lines 64 – 66).

***Allowable Subject Matter***

6. Claims 18, 19, 2- 23, 25, and 29 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

7. The following is a statement of reasons for the indication of allowable subject matter: The prior art fails to show film has a hardness of between about 30 to about 90 shore A, film has a hardness about 60 shore A, lens has a percent spectral transmission in the deactivated state between about 75 to about 95% T, activated state between about 10 to about 50%T, elastomeric material selected group from the group consisting of: polyethans, thermoplastic, elastomers, fluoroelastomers, copolyester elastomers, chlorosulfonated polyethylenes , neoprenes, polydimethylsiloxanes, ethyl vinyl acetates, polysulfates and mixtures thereof, and a photochromic dye is selected from the group of reversible photochromic compounds consisting of: spirooxazine, naphthopyran, chromene, spiroindolinonaphthoxazine, and mixtures thereof, and the lens is selected from the group consisting of optical quality resin materials consisting of : diethylene glycol diallyl carbonate, allyl diglycol carbonates, allylic esters, acrylicsters, acrylates, methyl, allyl and butyl methacrylates, polycarbonates, styrenics, polyesters, allyl diglycol carbonates, triallyl cyanurate, triallyl phosphate, triallyl citrate, diallyl phenyl

phosphonate, urethanes, poxies and silicone, polycarbonate resin, and an optical quality resin comprises allyl diglycol carbonate and elastomeric film is made from a poyurethene.

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The closest prior art

Kohan (5,975,696) process for rendering plastic substrate photochromic.

Sakagami et al (4,756,973) discloses photochromic lens.

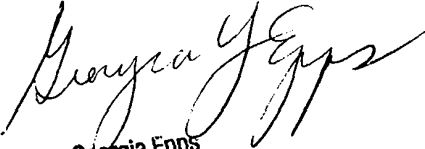
### **Conclusion**

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mohammed Hasan whose telephone number is (703) 306-0089. The examiner can normally be reached on M-TH, 7:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Georgia Epps can be reached on (703) 308-4883. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

MH  
October 9, 2003

  
Georgia Epps  
Supervisory Patent Examiner  
Technology Center 2800